

Atty. Docket No. DE919990077
(590.161)

REMARKS

Applicants and the undersigned are most grateful for the time and effort afforded the instant application by the Examiner. In the Office Action dated April 16, 2007, pending Claims 1, 3-6, 8, 10-14, 16, 20 and 23 were rejected. In response Applicants have filed herewith an Amendment. Claims 1, 10 and 12 have been rewritten; no claims have been cancelled. The Examiner is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the foregoing amendments and the following remarks.

Applicants are not conceding in this application the claims amended herein are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Rejection of claims under 35 U.S.C. § 103(a)

Claims 1, 3-6, 8 and 10-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,029,150 to Kravitz (hereinafter "Kravitz") in view of U.S. Patent 6,023,689 to Herlin et al. (hereinafter "Herlin") and further in view of U.S. Patent 6,574,314 to Martino (hereinafter "Martino"). The Examiner cites additional references, namely U.S. Patent 5,739,512 to Tognazzini, U.S. Patent 6,556,680 to Leonardi, and U.S.

Atty. Docket No. DE919990077
(590.161)

Patent 6,658,248 to Lee, as teaching "these concepts", apparently in an effort to cite them against some or all of the specific limitations of claims 1, 3-6, 8 and 10-13. Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz in view of Herlin and Martino and further in view of U.S. Patent Publication No. 2002/0111164 of Ritter et al. (hereinafter "Ritter"). Claims 14, 20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz in view of Herlin and Martino, and further in view of U.S. Patent Publication No. 2002/0100798 of Farrugia et al. (hereinafter "Farrugia"). Applicants respectfully request reconsideration and withdrawal of these rejections in light of the foregoing amendments and the following remarks.

To the degree that Applicants have previously addressed the above-mentioned rejections in their responses, those comments are fully incorporated by reference as if set forth herein.

As the Examiner is no doubt aware, in order to establish a *prima facie* case of obviousness three criteria must be met. First, there must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered as a whole including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

Atty. Docket No. DE919990077
(590.161)

As an initial matter, Applicants respectfully direct the Examiner's attention to the instant Specification wherein it states: "objects of the present invention are accomplished by [a particular method] based on existing sophisticated security mechanisms as provided by SIM cards and the existing billing system of the telecommunication companies."

Specification, page 2. Thus, it is unremarkable that the Examiner is able to find some of the elements of the instantly claimed invention in a number of prior art references, as the instantly claimed invention, in certain aspects, makes use of various components and techniques that already exist. Applicants respectfully submit, however, that the instantly claimed invention makes a novel and nonobvious combination of existing elements, along with novel and nonobvious method steps, to produce the instantly claimed invention.

Applicants respectfully submit that merely listing the elements of the invention, to the extent the Examiner is able to do so, in a piecemeal fashion from various references to support a case of obviousness without providing sufficient suggestion or motivation for doing so, and without taking into account the overall teachings of the references in the process, is improper. MPEP § 2142. Applicants respectfully submit that the Examiner has not pointed to prior art references that teach, either alone or in combination, all the limitations of the instantly claimed invention; furthermore, the Examiner has not provided evidence of obviousness based on a suggestion or motivation to combine the references by taking into account the teachings of the entire reference.

Applicants respectfully submit that the cited references fail to teach the limitations of the claimed invention. Claims 1, 3-6, 8 and 10-13 stand rejected under 35

Atty. Docket No. DE919990077
(590.161)

U.S.C. § 103(a) as being unpatentable over Kravitz in view of Herlin and further in view of Martino. The independent claims recite, in pertinent part, the method limitation of "confirming the encrypted digital signature of said receipt by a confirmation center." As already pointed out in a previous Amendment, Kravitz provides that "[t]he merchant can verify the validity of the digital signature contained in the received payment advice message portion." As can be seen then, Kravitz teaches that **the merchant, i.e. the provider of goods or services, not a confirmation center, performs the confirmation of the digital signature contained in the payment advice message.** This teaching stands in stark contrast to Applicants' invention wherein the digital signature of the payment provider is confirmed by **a confirmation center separate from the service provider.** The Examiner has provided no explanation for the conclusory statement that "Kravitz discloses...confirming the encrypted digital signature of said receipt by a **confirmation center.**" *Office Action*, page 3 (emphasis added).

Solely in an effort to expedite prosecution, Applicants have further amended the independent claims to recited, *inter alia*, the following:

wherein a telecommunication provider authenticates customer identification data using a subscriber identification module (SIM) of said electronic communication device prior to establishing said connection ...transmission of a money transfer order from said customer to a payment provider via the telecommunication provider, wherein the telecommunication provider authenticates that the customer is authorized to give a money transfer order using the subscriber identification module (SIM) of said electronic communication device.

Claim 1. This language is intended to clarify that the instantly claimed invention identifies the customer using a SIM in a device to grant access to service providers and

Atty. Docket No. DE919990077
(590.161)

authorize money transfers, in lieu of utilizing credit card information or traditional smart card applications to perform money transfers and identifications. *Specification*, pages 2-5. Thus, the invention offers the benefit of a secure payment method readily employed by millions of users having a SIM without the need for additional hardware. *Id* at page 3.

None of the references cited by the Examiner account for the deficiencies in Kravitz discussed above. Applicants respectfully submit that rejection of the current claims based on any combination of these references with Kravitz would therefore be improper. Applicants respectfully submit that the independent claims, and claims depending therefrom, are thus allowable over Kravitz, Herlin and Martino, and any other combination of references cited by the Examiner. Applicants respectfully request that the Examiner withdraw the rejections presented in the outstanding Office Action.

Although the claims are clearly distinguishable from Kravitz, and none of the cited references account for the deficiencies of Kravitz, in order to facilitate expeditious prosecution, Applicants undertake to address the remaining rejections in the Office Action. By way of example, Applicants point out that some of the cited references are not combinable art with Kravitz.

Regarding Herlin, cited by the Examiner as teaching the use of SIM for authentication at Col. 2, lines 10-40, the Examiner's attention is respectfully directed to Herlin, wherein it is stated "[w]hile the above-described procedures used in GSM [i.e. using the IMSI as an identification]...provide communications security, none of these procedures is entirely immune to interception and eavesdropping." *Herlin*, Col. 3, lines 43-46. "It would, therefore, be advantageous to provide a method for secure

Atty. Docket No. DE919990077
(590.161)

communications between users operating in a telecommunications system, in which public key methods were used to verify the identities of communicating parties." *Herlin*, Col. 4, lines 48-51. Thus, Herlin teaches away from the use of GSM based identification in favor of a new combination decryption key-public key method, in stark contrast to the instantly claimed invention. *Specification*, page 2. Thus, Applicants respectfully submit that Herlin does not teach use of SIM for identification, but teaches away from using SIM for identification by forwarding a different method of identification. *Herlin*, Col. 10, line 40-Col. 12, line 30.

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz in view of Herlin and Martino and further in view of Ritter. Without addressing the merits of the rejection, Ritter's earliest prior art date is after the instant application's filing date. Thus, Ritter's earliest effective prior art date is antedated by the instant application's filing date, i.e. January 2, 2001, and Ritter is unavailable as prior art for use in a 35 U.S.C. 103(a) rejection. Applicants are fully prepared to address the merits of this rejection upon a showing that Ritter is available as prior art and specifically reserve the right to address the merits should the need arise.

Claims 14, 20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz in view of Herlin and Martino and further in view of Farrugia. Farrugia's teachings are inapposite to, and actually teach away from, the instantly claimed invention. As best understood, Farrugia teaches the use of a modified SIM card for use of internet applications when other, preferable smart cards/card readers are not available. *Farrugia*, [0021]-[0022]. Indeed, Farrugia teaches away from preferably using SIM in

Atty. Docket No. DE919990077
(590.161)

combination with a mobile device, such as a cellular telephone or a computer, by stating "[h]ence, it is most likely that, whenever possible, the user will desire to access the application by means of the personal computer [] using a conventional, ISO-compliant smart card, and limit access via the device [e.g., a mobile telephone] to those situations where the appropriate reader is not available." *Id* at [0029]. Moreover, Farrugia does not teach or suggest using SIM for identification, but rather teaches use of a modified SIM card on a mobile device for accessing applications via the internet when the traditional computer/smart card combination is not available. *Id*. Therefore, Farrugia does not teach or suggest a personal computer using a SIM, as is the Examiner's contention, but rather suggests using a modified SIM with a mobile device (e.g. a cellular telephone) when a personal computer with traditional smart card is not available. *Office Action*, page 7.

Farrugia is thus problematic for use in a 35 U.S.C. § 103(a) obviousness rejection. The teachings stand in stark contrast to the instantly claimed invention wherein the use of SIM card is preferred to readily identify the customer in transactions. Therefore, Applicants respectfully submit that the teachings of Farrugia, alone or in combination with the various other references cited by the Examiner, is insufficient to render the claimed invention obvious under 35 U.S.C. § 103(a) and these rejections should be withdrawn.

In view of the foregoing, it is respectfully submitted that independent claims 1 and 12 fully distinguish over the applied art and are thus are in condition for allowance. By virtue of dependence from what are believed to be allowable independent claims, it is

Atty. Docket No. DE919990077
(590.161)

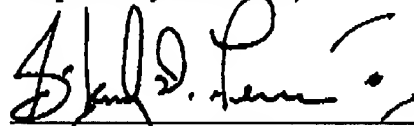
respectfully submitted that claims 3-6, 8, 10, 11, 13, 14, 16, 20 and 23 are also presently allowable.

Request for Telephone Interview

On August 16, 2007, Applicants' representative contacted the Examiner to schedule a telephone interview. It was agreed that a telephone interview would be conducted upon the Examiner having the opportunity to take up and consider the instant Amendment. Applicants respectfully submit that this is a particularly appropriate request in light of the prosecution history of the instant application, in which several amendments have been submitted and a second Request for Continued Examination has been granted.

In summary, it is respectfully submitted that the instant application, including claims 1, 3-6, 8, 10-14, 16, 20 and 23, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 47049
FERENCE & ASSOCIATES LLC
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicants